

Appl. No.: 09/731,359
Amdt. Dated June 28, 2006
Reply to Office Action of December 28, 2005

Docket No.: 30410/36981

Amendments to the Drawings:

The attached sheets of drawings include changes to Figs. 2, 3A, 3B, 4A, 4C, 5, 6, 7A-7C, 8A-8C, 9A, 9B, and 10C-10J. The figures are included with the substitute specification enclosed herewith.

REMARKS

This Amendment is in response to the Office action dated December 28, 2005 and accompanies a Rule 132 Declaration of Carl E. Moore, Jr. and a petition for a three month's extension of time to June 28, 2006. The Office action objects to several figures and rejects claims 104, 108, 121, 122, and 125 under 35 U.S.C. §112 second paragraph and claims 104-112 and 121-126 as being unpatentable under 35 U.S.C. §103(a) over Fredlund et al. ("Fredlund") (U.S. Patent No. 5,666,215) in view of Morris et al. ("Morris") (U.S. Patent No. 5,153,936). The applicants respond as follows.

The Rule 132 Declaration of Carl E. Moore, Jr. is submitted to rebut the allegations of obviousness and to provide factual evidence of commercial success of the invention recited in the pending claims.

SECTION 112 REJECTIONS

A substitute specification was requested in the Office action. Accordingly, applicants have submitted herewith a version of the specification that includes markings showing all changes relative to the immediate prior version of the specification of record and a clean version (without markings). No new matter has been added.

With respect to the objections to the drawings, applicants contend that the location of the figure numbers comply with the statutory requirements of 35 U.S.C. §112 and 37 CFR §§1.83-4, but in the interest of expediting prosecution, several of the figures have been amended to move the location of the figure number to the upper left corner of the figures to address the examiner's concern. Applicants further contend that the line weights in figure 2 and the shading in figure 10C comply with the statutory requirements of 35 U.S.C. §112 first paragraph, but in the interest of expediting prosecution, applicants have amended figure 2 to reduce the line weights of several lines and have amended figure 10C to remove the shading from elements 768, 770, 772, 774, and 776.¹ The Office action correctly states on page 4 that the acronym "OPI" corresponds to "Open-Pre-press Interface." The acronym OPI is also consistently used in the specification in this manner. Applicants submit that use of the acronym "OPI" in figure 4C complies with the statutory requirements of 35 U.S.C. §112 first paragraph, but in the interest of expediting prosecution, applicants have amended

¹ Applicants respectfully submit that there is no shading in elements 786 and 788 as indicated on page 4 of the Office action.

figure 4C to replace “OPI” with “Open-Pre-press Interface (OPI)” as requested in the Office action.

It is alleged on pages 2 and 5 of the Office action that use of the phrase “such that” in claims 104, 108, 121, 122, and 125 “renders the claims indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention.” Applicants believe that claims 104, 108, 121, 122, and 125 fully meet the requirements of 35 U.S.C. §112 second paragraph and respectfully traverse this rejection. The Office action cites to MPEP §2173.05(d) for support of this indefiniteness allegation. The reliance on this section of the MPEP is inappropriate because section 2173.05(d) of the MPEP addresses exemplary claim language, including terms “for example,” and “such as.” The term “such as” has substantially different meaning in a claim than “such that.” The term “such that” is in no way exemplary claim language.

The term “such that” in claims 104, 108, 121, 122, and 125 is an introductory phrase that introduces the limitations that follow the term. Thus, contrary to the allegation on page 5 of the Office action that “it is unclear whether the limitations following the phrases are part of the claimed invention,” the recitations following the term “such that” are indeed part of the claimed invention. Thus, Applicants respectfully request withdrawal of this rejection.

In the interest of expediting prosecution, claim 104 has been amended to address the examiner’s concern relative to the limitation “high resolution digital image” in line 23. Regarding claim 108, the applicants are not able to find a basis for the examiner’s allegation that a similar antecedent basis problem exists relating to “high resolution digital image.” The applicants respectfully request clarification.

The Office action rejects claims 108, 111, 112, and 124 on page 5 as being “incomplete for omitting essential elements, such omission amounting to a gap between the elements.” Applicants submit that claims 108, 111, 112, and 124 fully meet the requirements of 35 U.S.C. §112 second paragraph and respectfully traverse this rejection. Applicants submit that these claims do not omit essential elements. While the applicants have exercised economy of language in several claim recitations, they have not omitted essential elements and the claims particularly point out and distinctly claim the subject matter which the applicants regard as their invention.

Specifically, the Office action rejects claim 108 because the applicants have used the term “the subset” in line 11 when referring to “the subset of the digital images.” Shortening the term ‘the subset of the digital images’ to “the subset” meets all of the requirements of 35 U.S.C. §112 as there is only one subset recited in claim 108 (i.e., “the subset of the digital images” as recited in line 9). Thus, there are no essential elements omitted and no ambiguity as to what subset the applicants are referring to in line 11 of claim 108. It is a commonly accepted practice to utilize economy of language when referring to a claim term previously introduced that is several words long. This practice keeps claims concise and improves their readability, which allows the public to better understand what the boundaries are of a particular invention.

Applicants also submit that there are no essential elements omitted and no ambiguities as to the shortened terms used in claim 111, 112, and 124. The applicants have exercised economy of language in these claims, but have done so maintaining proper antecedent basis and sufficient language to ensure that no ambiguities exist within the claims. For at least the reasons stated above, the applicants believe that claims 108, 111, 112, and 124 meet the requirements of 35 U.S.C. §112 and that the rejections should be withdrawn.

A suggestion for an amendment to claim 122 was provided on page 2 of the Office action to overcome an objection relative to the language present on lines 11 and 12. In the interest of expediting prosecution, claim 122 has been amended to address the examiner’s concern. Specifically, in line 11 of claim 122 “and” has been changed to “or.” The applicants appreciate the suggestion provided in the Office action, but have amended the claim differently because the suggested amendment could be construed as incorrectly changing the scope of the claim.

CLAIMS 104-112 AND 121-126 MEET THE REQUIREMENTS OF SECTION 103(a)

The system in accordance with the current disclosure and as recited in pending claims 104-112 and 121-126 is a sharing system, in that an image provider may identify an authorized user in addition to the image provider capable of accessing digital images supplied by the image provider. Neither Fredlund nor Morris disclose such a system. Fredlund discloses a system where the only user identified to have access to the images is the image provider and there is no capability to identify authorized users other than the image provider.

In short, Fredlund does not teach or suggest the capability to identify additional authorized users. Likewise, Morris does not disclose a sharing system in which the image provider may identify additional authorized users. Therefore, the applicants submit that the inventions set forth in these claims meet the requirements of 35 U.S.C. §103(a), respectfully traverse the rejections of the Office action and request reconsideration.

Moreover, as detailed in the Rule 132 Declaration submitted by Mr. Carl E. Moore, Jr. and attached hereto, the claimed invention has enjoyed significant commercial success as evidenced by the substantial licenses taken under the issued Jebens et al. patents and the present application. To date, companies reportedly representing nearly ninety percent (90%) of the online photo services market have paid more than ten million dollars (\$10,000,000) in licensing fees for the right to practice the inventions claimed in this application and the two earlier issued patents.

At the outset, applicants note that the Office action of December 28, 2005 failed to respond in a meaningful way to the arguments presented by the applicants in the Amendment submitted October 6, 2005. The §103(a) claim rejections appear to be merely a copy of the §103(a) claim rejections presented in previous Office actions. The applicants respectfully request the Office to engage the applicants in a meaningful discussion relative to the arguments presented below.

Claims 104, and claims 105-107 dependent therefrom, are not rendered obvious by Fredlund and Morris. It is admitted in the Office action on pages 6 and 7 that Fredlund does not teach the claim limitation “means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy to the authorized user.”

Allegations are presented in the Office action that Morris discloses, at col. 1, line 63 - col. 2 lines 1-4, a means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy of the high resolution digital image, wherein the notifying means transmits at least a portion of a

pathname associated with the low resolution copy of the authorized user. The applicants respectfully disagree. Morris discloses a workstation coupled to a disk drive system for storing high and low resolution copies of a digital image. Morris does not disclose or suggest the claimed recitation of authorized users of any kind. Nor does Morris disclose or suggest any kind of notification. Thus, Morris clearly does not disclose or suggest notification to authorized users. It follows that Morris does not disclose or suggest that users are authorized for access to digital images, of either high or low resolution. Furthermore, Morris does not disclose or suggest pathnames associated with digital images. Moreover, even if Morris supplied the elements missing in Fredlund, there is no suggestion to combine the references. The stated motivation to combine, found on page 7 of the Office action, relies on elements that are in neither of the references, i.e. third party access, downloading messages with images, and electronic addresses (Internet URLs), suggesting perhaps a reliance on unacceptable hindsight.

In summary, it is admitted in the Office action that Fredlund does not teach a means for notifying an authorized user. Morris does not teach or suggest, as discussed above, authorized users, notification, or pathnames used in the notification. Nor is there a motivation to combine Fredlund and Morris. For at least these reasons, Fredlund and Morris do not teach all the limitations of claims 104, and the rejection under 35 U.S.C. § 103(a) should be withdrawn. As claim 104 is allowable, its dependent claims 105-107 are allowable as well.

Claim 121 is rejected on page 4 of the Office action for the same reasons as claim 104, and claim 125 is rejected on page 9 of the Office action for the same reasons as claim 104. Claims 121 and 125 do not recite the same limitations pointed to in the Office action as finding correspondence in the Fredlund and Morris combination. Therefore, the rejection of claim 104 should not be applied to claims 121 and 125.

Regarding claims 108, 111, and 126, it is alleged in the Office action that the addition of a mail server and router would have been obvious in view of Fredlund's modem and interactive cable TV network to provide mail services and to connect two or more networks. We respectfully disagree with this allegation, but the point is moot because

Fredlund does not teach or suggest all of the limitations of the claims, as Fredlund does not teach a sharing system. Therefore, the claims are allowable.

Moreover, Fredlund does not teach, disclose or suggest all of the limitations in the claims because it does not teach, disclose or suggest adding e-mail servers. In fact, the only mention of mail of any kind is surface mail in the first-described embodiment of the system (col. 3, lines 37-42). Fredlund's frequent references to surface mail for relaying data and orders teach away from electronic notification as claimed. For example, col. 6, lines 50-63 describe placing a final order by dialing a dedicated telephone number or mailing a diskette with instructions.

The Office action rejected claims 112, 122, 123, and 124 as being obvious in view of Fredlund and Morris. The applicants respectfully traverse. As provided by the MPEP at 2144.03(C) the applicants request documentary evidence of the examiner's allegation that the following would have been obvious: "a job order developer responsive to inputs received from the first user for developing a job order that includes at least one high resolution copy of a digital image contained in the subset and identified by the first user for discriminating between users communicating with the system to control user access to the digital images provided by the first digital image provider, wherein the digital images provided by the first digital image provider are transparent to all users except users identified by the first digital image provider."

Further, since neither Fredlund or Morris teach or suggest email notification or granting access to third parties, claims 112, 122, 123, and 124 are allowable and the rejection should be withdrawn.

The applicants remind the examiner that in order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to combine or modify must be made. See, for example, Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) and In re

Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine or modify serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal.

Indeed, the law is quite clear that an obviousness rejection must be based on facts, not conjecture. Thus, applicants assert that the examiner has not carried the required burden to establish a *prima facie* case of obviousness because there is no teaching or suggestion in either Fredlund or Morris to provide: 1) a sharing system in which an image provider may identify an authorized user in addition to the image provider capable of accessing digital images supplied by the image provider; 2) means for notifying an authorized user; 3) a mail server and router; 4) pathnames associated with digital images; or 5) a job order developer responsive to inputs received from a first user for developing a job order. It would not be obvious to modify either Fredlund or Morris to include any of these features and the examiner has provided no references that teach or suggest that such modifications would be possible, let alone beneficial. Therefore, a *prima facie* case of obviousness has not been established.

Even assuming that such a *prima facie* case of obviousness could be shown, 37 CFR 1.132 permits applicants to submit objective evidence of secondary considerations in the form of affidavits or declarations to traverse an obviousness rejection. Accordingly, applicants have timely submitted with this Amendment a Rule 132 Declaration of Mr. Carl E. Moore, Jr.

As recited in Mr. Moore's Declaration, to date, licensing revenues in excess of ten million dollars (\$10,000,000) have been received pursuant to licenses for the Jebens et al. patents (U.S. 6,321,231 and U.S. 6,332,146) and the pending Jebens et al. patent application, which is a continuation of the issued Jebens et al. patents. There are currently several licensees, and more than one of these licensees are Fortune 100 companies.

These licensees are sophisticated companies and have substantial expertise in the technical, legal, and business areas of the online photo services market. In addition, a number of these companies have substantial patent portfolios of their own. The licenses taken cover the manufacture and sale of systems built in accordance with the present application, and the performance of a method performed in accordance with the present application.

According to Info Trends, Inc., Online Photo Services Market Forecast: 2005-2010 (February 13, 2006), the licensees represented in excess of an estimated 84% of the online photo services market in 2004. Info Trends, Inc. projected that the share for these licensees was expected to increase for 2005 to the point that the licensees will likely represent in excess of 88% of the online photo services market. VPS, LLC, the assignee of the Jebbens et al patents and the present patent application, continues its licensing program and is in direct negotiations with other companies that are in the online photo services market. Info Trends, Inc. estimates that the total worldwide online photofinishing revenues for 2004 were over \$450 million, and are expected to surpass \$1.2 billion in 2010.

Because a *prima facie* case of obviousness has not been established and because the obviousness rejection in the Office action has been rebutted by the attached Rule 132 Declaration, the rejection of claims 104, 108, 111, 112, 121-126 and the claims depending therefrom, should be withdrawn.

In view of the foregoing, all of the claims are allowable over the cited references, and passage to allowance is respectfully requested. The amendments to the claims are made for clarification of antecedent basis or for broadening their scope. None of the claims have been narrowed for reasons related to patentability.

The Examiner is respectfully requested to pass this application to issue. If the examiner wishes to discuss any aspect of this response or the case in general, she is urged to contact the applicants' undersigned attorney. Should any additional fees be required, the Commissioner is authorized to charge or debit Deposit Account No. 13-2855.

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